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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/630,531	07/30/2003	Daniel R. Morris	037925.0004	9255
7590 Thomas F. Bergert Williams Mullen Suite 700 8270 Greensboro Drive McLean, VA 22102				
EXAMINER				
MEYERS, MATTHEW S				
ART UNIT		PAPER NUMBER		
3689				
MAIL DATE		DELIVERY MODE		
11/17/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/630,531

Applicant(s)

MORRIS, DANIEL R.

Examiner

MATTHEW S. MEYERS

Art Unit

3689

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 November 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 and 24-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 and 24-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/S508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This action is in response to applicant's communication on 11/08/2007, wherein claims 1-16 and 24-28 are pending, with claims 17-23 cancelled.

Priority

1. Applicant's claim for the benefit of a prior-filed application under 35 U.S.C. 119(e) or under 35 U.S.C. 120, 121, or 365(c) is acknowledged.

Information Disclosure Statement

2. The information disclosure statements(IDSs) submitted are being considered by the examiner.

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 24-28 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

2. Claims 24-26 are rejected under 35 U.S.C. 101 because In order for a method to be considered a "process" under §101, a claimed process must either: (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying

subject matter (such as an article or materials). *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972). If neither of these requirements is met by the claim, the method is not a patent eligible process under §101 and is non-statutory subject matter. With respect to claims 24-26, the claim language does not include the required tie or transformation and thus is directed to nonstatutory subject matter.

3. Claims 27-28 are drawn to a computer program per se. Computer programs per se intrinsically require no tangible physical structure, thus do not constitute tangible physical articles or other forms of matter. Therefore, computer programs per se are not considered to be statutory subject matter.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. **Claims 1-16 and 24-28** are rejected under 35 U.S.C. 103(a) as being unpatentable over *Feinberg et al.* (Pub. No.: US 2002/0107703) (Hereinafter referred to as *Feinberg*) in view of *MERS aids electronic mortgage market*, Mortgage Banking, January 1997 (Hereinafter referred to as *MERS II*).

4. With respect to **Claim 1**:

Feinberg discloses a computer-assisted method for ordering the tracking of a lien release (Feinberg [abs], "A method and system for automating the preparation, recordation, tracking and filing of liens, assignments, and other legal documents relating to securing payment of a debt or other obligation or transfer of ownership of an asset."), comprising the steps of:

providing, by input device, transaction information associated with at least one lien to a computer system for assisting loan settlements, said information including at least a settlement date and a lender identification associated with at least one property loan (Feinberg [0013], "A medical lien is then created by a separate software program 50 from the data on the database 40...The content and format of the document are specified by the guidelines stored in the database 40." and [0013], "The recording agency 60 reviews the document for proper format and content. If acceptable, the recording agency records the medical lien, giving it a recording number and a recording date." and Fig. 2); and sending, by the system, a signal to the input device indicating that the at least one lien has not been released and is due for release ("the client transmits an e-mail message to the data processing server via the Internet giving notice that the client has received proper payment for a given patient's services." and "The release is prepared according to guidelines from each jurisdiction previously stored on the database." Feinberg [0017] and [0016]);

Feinberg discloses the above limitations, but does not explicitly disclose requesting, by the input device, tracking of a release of said at least one lien by

said system to determine whether the at least one lien has been released according to a trigger date determined based on the settlement date or determining, by the system, that the at least one lien has not been released and is due for release. MERS II teaches requesting, by the input device, tracking of a release of said at least one lien by said system to determine whether the at least one lien has been released according to a trigger date determined based on the settlement date (MERS II, Page 5, "A method and system for automating the preparation, recordation, tracking and filing of liens, assignments, and other legal documents relating to securing payment of a debt or other obligation or transfer of ownership of an asset." and Page 5, "He notes that all parties will more easily be able to track loans to ensure that contractual obligations are being met." and Page 6, MERS can electronically transmit payoff amounts and other release information, Maher says. Until then, they are hoping MERS will enforce lien release requirements.") (Examiner is interpreting the trigger date as defined in applicant's specification at page 27, "The trigger date calculation can be jurisdiction-specific. For example, some jurisdictions may calculate deadlines for payoff lender releases of liens based on the date of settlement, others based on payoff date, and so forth. In another embodiment, the trigger date can be calculated based on an overdue release date. Statutory 25 requirements can be stored in a database accessible to the settlement agent and other entities identified above via network connection, for example, and such statutory requirements can be updated on an individual jurisdictional basis.") and

determining , by the system, that the at least one lien has not been released and is due for release (MERS II, Page 5, "He notes that all parties will more easily be able to track loans to ensure that contractual obligations are being met." and Page 6, MERS can electronically transmit payoff amounts and other release information, Maher says. Until then, they are hoping MERS will enforce lien release requirements.")

It would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the teachings of MERS II with Feinberg. Both references relate to lien tracking and their management. MERS II teaches about a system which generates an 18 digit mortgage identification number (MIN) for every origination. This MIN will stay with a loan throughout its life-even as ownership of the loan and its servicing changes hands. (MERS II, Page 1). The reason for this 18 digit mortgage identification number is to prevent cases where the mortgages have been paid off but in which no one files to release the lien. Feinberg teaches a method and system for automating the preparation, recordation, tracking and filing of liens, assignments, and other legal documents relating to securing payment of a debt or other obligation or transfer of ownership of an asset." (Feinberg [abs]). It would have been obvious at the time of the invention to have combined the MERS system with Feinberg in order to facilitate the management of these liens in order to avoid the pitfalls that often occur when the underlying note is bought, sold, transferred, securitized and so forth in accordance with market custom, since so doing could be performed readily and

easily by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results.

1. With respect to **Claim 2:**

Feinberg discloses providing contact information for at least one entity to be notified by said system in the event a release is due for said at least one lien (Feinberg [0011], "The client prepares an electronic data file of information including the patient's identification, patient's insurance information, the liable party's identification and the liable party's insurance information.").

5. With respect to **Claim 3:**

Feinberg discloses storing at least one trigger document in a database, whereby said trigger document is generated upon receipt of said signal (Feinberg [0012], "The server validates the data by comparing it to a set of guidelines, which have previously been stored on the database.").

6. With respect to **Claim 4:**

Feinberg discloses said step of requesting system monitoring is of lien records associated with said plurality of loans for said identified lender, and said at least one entity is said identified lender (Feinberg, [abs], "A method and system for automating the preparation, recordation, tracking and filing of liens, assignments, and other legal documents relating to securing payment of a debt or other obligation or transfer of ownership of an asset.").

7. With respect to **Claim 5:**

Feinberg discloses wherein said transaction information is related to a plurality of loans within an identified jurisdiction for a plurality of identified lenders, said step of requesting system monitoring is of lien records associated with said plurality of loans in said identified jurisdiction for said plurality of identified lenders (Feinberg, [abs], "A method and system for automating the preparation, recordation, tracking and filing of liens, assignments, and other legal documents relating to securing payment of a debt or other obligation or transfer of ownership of an asset.").

8. With respect to **Claim 6**:

Feinberg discloses wherein said transaction information is related to a plurality of loans within a plurality of identified jurisdictions for a plurality of identified lenders, said step of requesting system monitoring is of lien records associated with said plurality of loans in said plurality of identified jurisdictions for said plurality of identified lenders (Feinberg, [abs], "A method and system for automating the preparation, recordation, tracking and filing of liens, assignments, and other legal documents relating to securing payment of a debt or other obligation or transfer of ownership of an asset." and [0012], "The guidelines set forth the content and format of the information required to properly file a lien in each given jurisdiction. The guidelines are compiled from statutes, regulations, and local practice for each locale.").

9. With respect to **Claim 7**:

Feinberg discloses prompting said at least one entity for further contact information related to a second entity to be notified (Feinberg [0011], "Additional

information may be required, such as the type and location of the accident and the patient's attorney, if represented.”).

10. With respect to **Claim 8**:

Feinberg discloses requesting at least one trigger document associated with untimely notice of release or satisfaction of a lien (Feinberg [0014], “The patient is notified of the outstanding lien by the notification method specified by jurisdiction, typically by certified U.S. mail.”).

11. With respect to **Claim 9**:

Feinberg discloses requesting a status report of at least one lien record (Feinberg [0001], “This invention relates generally to data processing, and more particularly to automatic preparation, recordation, tracking and filing of liens, assignments, and other legal documents relating to securing payment of a debt or other obligation or transfer of ownership of an asset.”).

12. With respect to **Claim 10**:

Feinberg discloses a system for assisting with loan settlements, comprising:

a first electronic interface for receiving property-related lien transaction information, said information including at least a settlement date and a lender identification associated with at least one property loan, said interface further being capable of receiving a request for electronically tracking a release associated with a lien for said at least one property loan (Feinberg, [0007], “The present invention provides a method and system for automating the preparation, recordation, tracking and filing of liens, assignments, and other legal documents

relating to securing payment of a debt or other obligation or transfer of ownership of an asset. Certain lien information is provided by a lien holder to a centralized database via the Internet.”);

a second electronic interface for displaying lien status information corresponding to said lien, said status information including information as to whether said lien has been at released according to a trigger date based on the settlement date (Feinberg, Figs 1-3); and

an alert mechanism for receiving an electronic signal and notifying at least one entity in the event a release for said at least one lien has not occurred and is one of due or overdue based on statutory requirements associated with said identified lender (Feinberg [0017] and [0016] “The client transmits an e-mail message to the data processing server via the Internet giving notice that the client has received proper payment for a given patient's services.” and “The release is prepared according to guidelines from each jurisdiction previously stored on the database.” And Fig 3).

13. With respect to **Claim 11**:

Feinberg discloses a database of trigger documents, and wherein at least one trigger document from said database is generated upon receipt of said signal (Feinberg [0012], “The server validates the data by comparing it to a set of guidelines, which have previously been stored on the database.”).

14. With respect to **Claim 12**:

Feinberg discloses wherein said transaction information is related to a plurality of loans for an identified lender, said received request is for the tracking of a plurality of releases associated with a plurality of liens for said identified lender, and said at least one entity is said identified lender (Feinberg, [abs], "A method and system for automating the preparation, recordation, tracking and filing of liens, assignments, and other legal documents relating to securing payment of a debt or other obligation or transfer of ownership of an asset.").

15. With respect to **Claim 13**:

Feinberg discloses wherein said transaction information is related to a plurality of loans within an identified jurisdiction for a plurality of identified lenders and said received request is for the tracking of a plurality of releases associated with a plurality of liens in said identified jurisdiction for said plurality of identified lenders (Feinberg, [abs], "A method and system for automating the preparation, recordation, tracking and filing of liens, assignments, and other legal documents relating to securing payment of a debt or other obligation or transfer of ownership of an asset.").

16. With respect to **Claim 14**:

Feinberg discloses wherein said transaction information is related to a plurality of loans within a plurality of identified jurisdictions for a plurality of identified lenders and said received request is for the tracking of a plurality of releases associated with a plurality of liens in said plurality of identified jurisdictions for said plurality of identified lenders (Feinberg, [abs], "A method and system for automating the preparation, recordation, tracking and filing of liens, assignments, and other legal documents relating

to securing payment of a debt or other obligation or transfer of ownership of an asset.” and [0012], “The guidelines set forth the content and format of the information required to properly file a lien in each given jurisdiction. The guidelines are compiled from statutes, regulations, and local practice for each locale.”).

17. With respect to **Claim 15**:

Feinberg discloses wherein at least one of said interfaces is adapted to prompt-said at least one entity for further contact information related to a second entity to be notified (Feinberg [0011], “Additional information may be required, such as the type and location of the accident and the patient's attorney, if represented.”).

18. With respect to **Claim 16**:

Feinberg discloses a reporting component for generating a status report of at least one lien record (Feinberg [0001], “This invention relates generally to data processing, and more particularly to automatic preparation, recordation, tracking and filing of liens, assignments, and other legal documents relating to securing payment of a debt or other obligation or transfer of ownership of an asset.”).

19. With respect to **Claim 24**:

20. Feinberg discloses a method for managing lien releases (Feinberg [abs], “A method and system for automating the preparation, recordation, tracking and filing of liens, assignments, and other legal documents relating to securing payment of a debt or other obligation or transfer of ownership of an asset.”), comprising the steps of:

- a. providing an electronic interface to electronically stored identification information associated with at least one lien, including lien status information

based on note information and lien transaction information associated with the at least one lien, wherein the lien status information can include a status where a note has been paid but a lien not released or a status where a note has been paid and a lien is overdue for release (Feinberg [0013], "If acceptable, the recording agency records the medical lien, giving it a recording number and a recording date. The recording number and recording date are input into the software program 50, which forwards the information to the database 40 to update the associated records.");

b. electronically receiving a status report associated with said at least one lien including the status that the at least one lien has not been released and is due for release (Feinberg [0015], "Once the lien holder has been paid, a release or satisfaction is filed to indicate the debt has been paid. The process for releasing the lien is similar to filing a lien. FIG. 3 shows the process steps of the release system... the client 10 transmits an e-mail message to the data processing server 30 via the Internet 20 giving notice that the client has received proper payment for a given patient's services."); and

c. initiating, by the electronic interface, a response based on said status lien (Feinberg [0016], "A release is prepared by the software program 50 from the patient and insurance data previously transmitted and stored in the database 40 when the lien was originally prepared. The release is prepared according to guidelines from each jurisdiction previously stored on the database 40. The release is transmitted in electronic form to the appropriate recording agency 60").

21. With respect to **Claim 25**:

22. Feinberg discloses wherein said report includes an indication that said lien has an unreleased status and said response includes the generation of at least one of said electronic documents (Feinberg [0017] and [0016] "the client transmits an e-mail message to the data processing server via the Internet giving notice that the client has received proper payment for a given patient's services." and "The release is prepared according to guidelines from each jurisdiction previously stored on the database.").

23. With respect to **Claim 26**:

24. Feinberg discloses wherein said at least one of said electronic documents is one of: a demand letter, a legal form (Feinberg [0017] and [0016] "the client transmits an e-mail message to the data processing server via the Internet giving notice that the client has received proper payment for a given patient's services." and "The release is prepared according to guidelines from each jurisdiction previously stored on the database.").

25. With respect to **Claim 27**:

26. Feinberg discloses system for managing lien releases (Feinberg [0001], "This invention relates generally to data processing, and more particularly to automatic preparation, recordation, tracking and filing of liens, assignments, and other legal documents relating to securing payment of a debt or other obligation or transfer of ownership of an asset."), comprising:

- d. a lien management component for receiving and storing lien identification information (Feinberg [0013], "If acceptable, the recording agency records the

medical lien, giving it a recording number and a recording date. The recording number and recording date are input into the software program 50, which forwards the information to the database 40 to update the associated records.”);

e. an interface for accessing a lien status monitoring system, said lien status monitoring system including a lien searching component having access to lien records for a plurality of lien record-keeping jurisdictions, each of said lien records including a respective lien holder entry (Feinberg [0013], “The server 30 receives the transmission into the mailbox in the preferred embodiment.

Alternatively, the data can be transmitted directly to the server 30 from an on-line Internet account through a portal dedicated to receipt of data... The data is extracted from the message stream and stored on a storage means, represented in FIG. 1 as a database 40, as is known in the art.”);

f. means for providing notice to a lien holder associated with said at least one lien indicating that the at least one lien has not been released and is due for release (Feinberg [0016], “Once the lien holder has been paid, a release or satisfaction is filed to indicate the debt has been paid.”).

g. Feinberg discloses all the above limitations, but does not explicitly disclose means for determining a status of at least one lien, including the status that the at least one lien has not been released and is due for release. MERS II teaches a means for determining a status of at least one lien, including the status that the at least one lien has not been released and is due for release (MERS II, Page 5, “He notes that all parties will more easily be able to track loans to ensure

that contractual obligations are being met." and Page 6, MERS can electronically transmit payoff amounts and other release information, Maher says. Until then, they are hoping MERS will enforce lien release requirements.").

It would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the teachings of MERS II with Feinberg. Both references relate to lien tracking and their management. MERS II teaches about a system which generates an 18 digit mortgage identification number (MIN) for every origination. This MIN will stay with a loan throughout its life-even as ownership of the loan and its servicing changes hands. (MERS II, Page 1). The reason for this 18 digit mortgage identification number is to prevent cases where the mortgages have been paid off but in which no one files to release the lien. Feinberg teaches a method and system for automating the preparation, recordation, tracking and filing of liens, assignments, and other legal documents relating to securing payment of a debt or other obligation or transfer of ownership of an asset." (Feinberg [abs]). It would have been obvious at the time of the invention to have combined the MERS system with Feinberg in order to facilitate the management of these liens in order to avoid the pitfalls that often occur when the underlying note is bought, sold, transferred, securitized and so forth in accordance with market custom, since so doing could be performed readily and easily by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results.

27. With respect to **Claim 28**:

28. MERS II discloses wherein said means for determining a status includes requesting a search by said lien searching component (MERS II, Page 5, "He notes that all parties will more easily be able to track loans to ensure that contractual obligations are being met." and Page 1).

Response to Arguments

29. Applicant's arguments with respect to claims 1-16 and 24-28 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

30. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. MortgageServ, *Total Mortgage Servicing from fs*, Spring 2001 User Conference.

31. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MATTHEW S. MEYERS whose telephone number is (571)272-7943. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jan Mooneyham can be reached on (571) 272-6805. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Matthew S. Meyers/
Examiner, Art Unit 3689

/Janice A. Mooneyham/
Supervisory Patent Examiner, Art Unit 3689